

REMARKS

This amendment is being filed in reply to the Notice of Noncompliant Amendment mailed. Applicants responded to a non-final Rejection, a reply to which was due, without payment of additional fee or petition for extension of time to respond, by October 17, 2006. Applicant did not have the correct listing of the claims and have now correctly listed the status of the pending claims. Currently, claims 1-29 are pending in the application, of the above claims 5, 8-11, 17-19 and 21-26 are withdrawn from consideration and claims 1-4, 6, 7, 12-16 and 20 are rejected. By this amendment claims 1-26 have been cancelled and new claims 27-36 are presented for examination.

The newly presented claims 27-36 are each limited to the elected species, to wit: C₁-C₃ alkyl or dialkyl N-substituted menthane carboxamides as the cooling agents and C₇-C₁₂ alkanolic acid vanillamides as the cooling sensate enhancers. The original claims readable on the elected species, 1-26 have been cancelled, and more limited claims, 27-36 are presented herewith.

The Examiner has rejected Claims 1-4, 6, 7, 12-16 and 20 under 35 USC §103(a) as being unpatentable over Nakatsu et al. (European Published Patent Application 1,121,927 A2) in view of any of Beilharz et al. (U.S. Patent 5,494,675), Rapaport (U.S. Patent 5,730,965) or Michael (U.S. Published Patent Application 2001/0043912 published on Nov. 22, 2001).

Particularly in view of the more limited newly presented claims, taken together with the averments in the accompanying Affidavit of Dr. Richard Boden under 37 CFR §1.132 it is respectfully submitted that the rejection of the claims based on 35 USC §103(a) has been overcome.

Admittedly, Nakatsu et al. discloses a vast array of cooling and warming sensates useful in conjunction with a vast array of body care products including, but not limited to “shampoos”. Nevertheless, Nakatsu et al. fails to specifically or implicitly disclose the an

anti-dandruff shampoo comprising the unexpected combination of anti-dandruff agent : cooling sensate material :cooling sensate enhancer material of the specific classes of sensates and sensate enhancers to which applicants' invention is limited, namely:

“C₁–C₃ alkyl or dialkyl N-substituted menthane carboxamides as the cooling agents and C₇–C₁₂ alkanolic acid vanillamides as the cooling sensate enhancers”.

There exists no teaching, suggestion or motivation in the prior art to arrive at the the claimed combination of the present invention. Furthermore, the claimed combination is unexpected and unobvious in view of the prior art. **There is no indication of success to combine a cooling agent with C₇–C₁₂ alkanolic acid vanillamides, known as a warming material to achieve a desirable result.**

Aside from failing to disclose the use of *anti-dandruff* shampoos, the Nakatsu et al. reference is a classical example of a “shotgun” disclosure setting forth literally thousands of compounds, without even implying a utility for any of such compounds in conjunction with anti-dandruff shampoos. It is established case law that the application of such a “shotgun” disclosure in support of a 35 USC §103(a) rejection is overcome by a showing of “criticality” of a specific class of compounds for a particular use.

It is respectfully submitted that the requisite showing of such “criticality” has been made as a result of the averments as set forth in the Affidavit of Richard Boden under 37 CFR §1.132 wherein Dr. Boden avers:

“10. As a result of his review of the results of the experiments and results thereof as described in ¶9, supra, show has drawn the following conclusions:

- (a) With respect to the arithmetic average of effects (i) – (vii) in **TABLE III OF RESULTS**, in ¶9, supra, inclusion of the combination of the anti-dandruff agent, zinc pyrithione with the cooling sensate, 2-isopropyl-N,2,3-trimethyl butyramide and the cooling sensate enhancer, nonyl acid vanillamide both on use and 5 minutes post use enables the anti-dandruff shampoo to have significantly unexpected, advantageous and unobvious properties.
- (b) With respect to the soothing (i) effect as set forth in the **TABLE I OF RESULTS** supra, the combination of the anti-dandruff agent, zinc pyrithione, with the cooling sensate, 2-isopropyl-N,2,3-trimethyl butyramide and the cooling sensate

enhancer, nonyl acid vanillamide, both on use and 5 minutes post use enables the shampoo to have significantly unexpected, advantageous and unobvious properties.

11. It is his further conclusion, as a result of his conclusions as set forth in ¶10, *supra*, that the employment of the compositions and processes defined by claims 24 – 33 as set forth in ¶8, *supra*, give rise to significantly unobvious, advantageous and unexpected results when compared with the teachings of Nakatsu et al. taken in view of either Beilharz et al., Rapaport or Michael.”

Accordingly, it is respectfully submitted that the statement set forth by the examiner in support of the 35 USC §103(a) rejection:

“...it is conventional to employ anti-dandruff compounds because dandruff is a widespread cosmetic problem...”

cannot properly be applied to the instant situation, particularly in view of the showing of the criticality of the advantageous interaction of the anti-dandruff agent with the sensates and the sensate enhancers in order to provide the effects:

- i. a substantial soothing effect;
- ii. a deep-cleansed effect as measured by the IFF squeak test;
- iii. a significant itch reduction;
- iv. a substantial tingling effect;
- v. a substantial warming effect;
- vi. a substantial cooling effect; and
- vii. a significantly enhanced “menthol/medicinal” aroma.

Furthermore, by failing to disclose *anti-dandruff* compositions, **and** by including a vast array of other personal care compositions used with its disclosed sensates, it is respectfully submitted that the Nakatsu et al. reference teaches *away* from applicants’ invention.

Nor do any of the secondary references add anything to support the Nakatsu et al disclosure. Not one of the secondary references cited by the Examiner in charge of the above-identified application provides any clue of an interrelationship between that which

is taught by Nakatsu and the secondary reference teachings. Beilharz et al. discloses a method for treating dandruff based on the use of an alkali metal salt of a low molecular weight huminate with no implicit or explicit teaching of the utility of *any* sensates to be used in conjunction with the Beilharz anti-dandruff compositions. Rapaport teaches the use of an anti-dandruff composition containing chloroxylenol again with no implicit or explicit teaching of the utility of *any* sensates to be used in conjunction with the Rapaport anti-dandruff compositions. The only relevance to anti-dandruff compounds that the Michael reference, entitled: "HAIR CARE COMPOSITIONS CONTAINING SELECTED FRIZZ CONTROL AGENTS" has appears at page 9, column 2, paragraph 0107 and page 10, column 1, paragraph 0107 where the anti-dandruff compositions such as zinc pyrithione are indicated to be optional ingredients. At page 9, paragraph 0105, Michael indicates the use of heating and cooling sensates as "other non-essential ingredients" with no tie-in to anti-dandruff agents. Thus, it is respectfully submitted that the disclosure by the Michael reference of the use of the sensates, ethyl menthane carboxamide as well as trimethyl isopropyl butanamide (at the end of paragraph 0105) cannot be properly applied to the Nakatsu et al. disclosure in order to support a 35 USC §103(a) obviousness rejection.

The foregoing amendments and discussion, and the accompanying Affidavit of Dr. Richard Boden under 37 CFR §1.132 are respectfully urged to be fully responsive to the Office Action of July 17, 2006 and place this case in condition for allowance.

Accordingly, an early action and allowance of the above-identified application are respectfully solicited.

Respectfully submitted,

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